

REMARKS

Claims 1-8, 10-14, 34-44, 61-75, and 116-120 are presently pending in the application. Claims 9, 15-33, 45-60, and 76-115, have been removed from consideration as being directed to a non-elected invention. Claim 120 has been added. Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

As a preliminary matter, the Applicants thank the Examiner for the courtesies extended during the interview of December 12, 2006. In the interview, the Applicants forwarded the argument that an anticipation rejection was not reasonable since the claims recite features, such as "a single transfer lens", which are not disclosed in Grier et al. (USP 6,055,106). Further, the Applicants argued that the Examiner is not properly construing the claims as recited, since the claims require only a "single transfer lens", which language is limiting with respect to the number of transfer lenses which are disposed in the optical train, and not open-ended language as the Examiner alleges. No agreement was reached, but the Examiner kindly agreed to reconsider the Applicants arguments in the present Response.

Claim Rejection Under 35 U.S.C. 102

Claims 1-8, 10-14, 34-44, 61-75 and 116-119 are rejected under 35 U.S.C. 102(b) as being anticipated by Grier et al. (USP 6,055,106). For the following reasons, the prior art rejection is respectfully traversed.

The Applicants respectfully submit that Grier et al. do not teach or suggest a phase patterning diffractive optical element having a variable optical surface to form a plurality of beamlets, each beamlet having a phase profile; nor a single transfer lens through which beamlets are directed from the phase patterning optical element, to form the multiple optical traps, as recited in Claim 1, and as substantially recited in Claims 10 and 116.

Further, the diffractive optical element having a virtual lens encoded therein, as recited by Claims 34, and 61, is not taught or suggested by Grier et al.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since the phase patterning optical element having a variable optical surface, the single transfer lens, and the virtual lens encoded on the phase patterning optical element are not taught or suggested by Grier et al., Grier et al. can not anticipate the claims of the present invention.

Further, the Applicants respectfully submit that if the claims recite features which are not present in the applied prior art, it is not necessary for the Applicant to provide reasoning (which is related to overcoming an obviousness rejection under 35 USC §103), as the Examiner alleges in the Office Action, as to why the invention is not "anticipated" by the applied prior art. The fact that the features recited in the claims are not present in the applied prior art should be sufficient to overcome an anticipation rejection.

Further, it is not obvious to achieve the optical traps of the present invention by adding such a virtual lens, or a single transfer lens, in place of the telescope lens system used in Grier et al. One of ordinary skill in the art would not have been motivated, without using impermissible hindsight, to modify Grier et al. to such an extent as to eliminate the telescope lens which appears to be required from that reference, to achieve the claimed features of the present invention.

Still further, the use of a "single" transfer lens is not "open-ended language" as the Examiner alleges, but rather, limiting language. The Examiner may be thinking of the use of

wording such as "a" transfer lens, which is open-ended language, but the limitation of a "single" transfer lens makes the lens limited to a "single" lens, and not multiple lenses.

Rather, in the present invention, by using a diffractive optical element (with a virtual lens encoded thereon), in combination with a single transfer lens, the present invention produces diffracted beamlets that have altered phase profiles, such that optical traps are formed and can be independently and selectively controlled.

Accordingly, Claims 1, 10, 34, 61, and 116 are neither anticipated by, nor obvious over Grier et al., and the Examiner's rejection under 35 U.S.C. 102(b) should be withdrawn.

Further, since Claims 2-8, 11-14, 35-44, 62-75, and 117-119, depend from Claims 1, 10, 34, 61, and 116, they are also patentably distinguishable over Grier et al. for the reasons cited above with respect to Claims 1, 10, 34, 61, and 116.

Claim 120 has been added, and should be found allowable.

Thus, the claims should be in form for allowance and such action is hereby solicited.

If the Examiner believes that there is any issue which could be resolved by a telephone or personal interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such an extension is to be charged to Deposit Account No. 50-0951.

Respectfully submitted,

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